



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/880,173      | 06/13/2001  | Tomoyuki Asano       | 09792909-5110       | 7206             |

26263 7590 04/08/2003

SONNENSCHN NATH & ROSENTHAL  
P.O. BOX 061080  
WACKER DRIVE STATION  
CHICAGO, IL 60606-1080

EXAMINER

GRAHAM, CLEMENT B

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

3628

DATE MAILED: 04/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/880,173

Applicant(s)

ASANO, TOMOYUKI

Examiner

Clement B Graham

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patent ability shall not be negated by the manner in which the invention was made.

2. Claims 17-28, are rejected under 35 U.S.C. 103(a) as being unpatentable over Hereinafter Daly U. S. Patent No 5,878,141).

As per claims 17-20, Daly disclose a method for accounting for a fee concerning service provided to a user by a service provider to a user, comprising the steps of: receiving from said service provider a charge collection request based on a service request sent from the user to said service provider, also disclose informing said charge collection to the user based on said charge collection request received from said service provider; and verifying validity of the charge based on said service request. (Note abstract and column 4 lines 15-30 and column 17 lines 60-65). Daly does not explicitly teach a digital signature generated based on service request when an objection to the fee is received from the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Daly would have been able to generate digital signature based on service request when an objection to the fee is received from the user. The benefit would have been to receive payment for services for a financial gain of an institution.

As per claims 21-24, Daly disclose a system for accounting for a fee concerning service provided to a user by a service provider to a user, comprising:

Art Unit: 3628

means for receiving from said service provider a charge collection request based on a service request sent from the user to said service provider;

means for informing said charge collection to the user based on said charge collection request received from said service provider; and means for verifying validity of the charge based on said service request. (Note abstract and column 4 lines 15-30 and column 17 lines 60-65). Daly does not explicitly teach a digital signature generated based on service request when an objection to the fee is received from the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the teachings of Daly would have been able to generate digital signature based on service request when an objection to the fee is received from the user. The benefit would have been to receive payment for services for a financial gain of an institution.

As per claims 25-28, Daly disclose a system for accounting for a fee concerning service provided to a user by a service provider to a user, comprising:  
an accounting terminal for receiving from said service provider a charge collection request based on a service request sent from the user to said service provider, wherein the accounting terminal informs said charge collection to the user based on said charge collection request received from said service provider, and verifies validity of the charge based on said service request. (Note abstract and column 4 lines 15-30 and column 17 lines 60-65). Daly does not explicitly teach a digital signature generated based on service request when an objection to the fee is received from the user. It would have been obvious to one of ordinary skill in the art at the time the invention was made that

Art Unit: 3628

the teachings of Daly would have been able to generate digital signature based on service request when an objection to the fee is received from the user. The benefit would have been to receive payment for services for a financial gain of an institution.

#### Conclusion

3. The prior art of record and not relied upon is considered pertinent to

Applicants disclosure.

Kolling et al (US Patent 5920847) teaches electronic bill pay system.

Silverman (US 6,252,869 Patent) teaches data network security system and method.

Lawlor (US Patent 5,220,501) teaches method and system for remote delivery of retail banking services.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

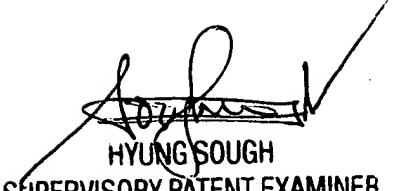
Application/Control Number: 09/880,173

Page 5

Art Unit: 3628

CG

March 31, 2003



HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600